

Application No. 09/991,247
Amendment dated April 21, 2004
Reply to Final Office Action of January 30, 2004

REMARKS

Applicant amended claims 25-28, 56-59, and 85-88 to further define Applicant's claimed invention. Applicant amended the specification to provide antecedent support for independent claims 1 and 29. Applicant also amended the specification to provide antecedent support for claims 10-12 and 14-17 as originally filed. No new matter has been added.

In the Office Action, the Examiner rejected claims 25-28, 56-59, and 85-88 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner contends that there is no support for an open-ended range of openings for driver instrument engagement. Applicant submits that one of ordinary skill in the art would reasonably conclude that Applicant had possession of the claimed invention at the time the present application was filed at least because Fig. 9A shows a trailing end having at least one opening for engagement with a driver instrument. Nonetheless, in order to expedite prosecution, Applicant amended 25-28, 56-59, and 85-88 to delete reference to the phrase "at least." Applicant submits that this rejection has been overcome.

The Examiner rejected claims 1-3 and 5-59 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. In particular, the Examiner contends that certain terminology in claims 1 and 29 does not have antecedent support in the specification. Applicant amended the paragraph bridging pages 10 and 11 and added a new paragraph on page 19 of the specification to provide antecedent support for claims 1 and 29. Applicant submits that this rejection has been overcome.

The Examiner rejected claims 1-3, 5-16, 18, 23-49, 55-78, and 84-88 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,860,973 to Michelson ("Michelson '973") in view of U.S. Patent No. 6,294,187 to Boyce et al. ("Boyce '187"). Applicant respectfully traverses the Examiner's rejection. Applicant submits that one of ordinary skill in the art would not look to the teachings of Boyce '187 when presented with the teachings of Michelson '973 because Boyce '187 fails to supply any motivation for modifying implants not made of bone such as taught by Michelson '973. Boyce '187

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teaches that it is desirable to modify bone grafts to have the capacity to support an initial load and gradually transfer the load to the host bone tissue as it remodels the implant. (Boyce '187, col. 2, lines 1-4). Nowhere does Boyce '187 suggest modifying implants not made of bone such as taught by Michelson '973 to be manufactured from a composite of cortical bone particles and at least one bioresorbable material as recited in independent claims 1, 29, and 60.

Applicant respectfully submits that the Examiner is applying impermissible hindsight gleaned from Applicant's disclosure to support the combination of Michelson '973 and Boyce '187. Applicant submits the teachings of Michelson '973 and Boyce '187 are mutually exclusive and that one of ordinary skill in the art would not look to combine the teachings of Michelson '973 and Boyce '187 without the benefit of Applicant's teachings in the disclosure of the present application. Accordingly, Applicant submits that the combination of Michelson '973 and Boyce '187 is untenable and cannot be maintained.

The Examiner also rejected claims 17, 50, and 79 under 35 U.S.C. § 103(a) as being unpatentable over Michelson '973 and Boyce '187 in view of U.S. Patent No. 5,899,939 to Boyce et al. ("Boyce '939"); and rejected claims 19-22, 51-54, and 80-83 under 35 U.S.C. § 103(a) as being unpatentable over Michelson '973 and Boyce '187 in view of U.S. Patent No. 5,484,437 to Michelson. Applicant submits that the rejections over claims 17, 19-22, 50-54, and 79-83 are rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

Accordingly, Applicant submits that independent claims 1, 29, and 60 are patentable over the art of record and that dependent claims 2, 3, 5-28, 30-59, and 61-88 dependent from one of independent claims 1, 29, and 60, or claims dependent therefrom are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

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